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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/692,497	10/24/2003	Bruce B. Roesner	16165-003001	9269
20985	7590	08/22/2006	EXAMINER	
FISH & RICHARDSON, PC			CABRERA, ZOILA E	
P.O. BOX 1022			ART UNIT	
MINNEAPOLIS, MN 55440-1022			PAPER NUMBER	
			2125	

DATE MAILED: 08/22/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/692,497	Applicant(s) ROESNER, BRUCE B.	
	Examiner Zoila E. Cabrera	Art Unit 2125	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 October 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 5-14 is/are allowed.
- 6) ☒ Claim(s) 1-4, 15, 16, 20-24 and 28-30 is/are rejected.
- 7) ☒ Claim(s) 17-19 and 25-27 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>2/22/06; 4/28/06</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-4 are rejected under 35 U.S.C. 102(e) as being anticipated by Green et al. (US 2005/0252605).

As for claims 1-4, Green discloses,

1. A radio frequency identification (RFID) tag assembling system comprising: an RFID module conveyor that moves a first substrate having multiple RFID modules [0016]; [0023]; [0027]; [0030]-[0031]; Figs. 11, 13, 15); an RFID antenna conveyor that moves a second substrate with respect to and into alignment with the first substrate, the second substrate having multiple RFID antennas ([0030]-[0031]; [0086]; Figs. 11, 13, 15); and a joiner to separate the RFID modules from the first substrate and attach the RFID modules to the RFID antennas on the second substrate ([0021];[0030];[0033]-[0035];[0060];[0088]).

2. The system of claim 1, wherein the joiner further comprises an adhesive applier ([0033]);[0072]).

3. The system of claim 1, wherein the joiner comprises a vacuum head, a sheering tool, and a placement arm ([00114]-[0115]; Figs. 11-12).
4. The system of claim 1, wherein the first substrate comprises a reel-form substrate ([0083]; [0107]-[0109]).

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 15-16, 20-22; 23-24, 28-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Green et al. (US 2005/0252605) in view of Grabau et al. (US 2002/0195195 A1)

As for claims 15 and 23, Green discloses the limitations of claim 1 above. Most of the limitations of claim 1 apply as well for claims 15 and 23. Green further discloses:

As for claims 16, 24, Green further discloses,
aligning and forming comprises aligning and forming the RFID tags in parallel (Figs. 11,12).

However, Green fails to disclose

As for claims 15, 20-22, 23 and 28-30, identifying which RFID modules on a substrate are functional; testing the FRID modules to identify the RFID modules that are fully functional for a predetermined application; programming the RFID modules; testing the RFID in parallel. However, Grabau teaches an RFID manufacturing system including a step of verifying the functionality of, or programming, the chips prior to a formation of a composite web ([0003], please note that verifying corresponds to testing which is made parallel, Fig. 1; [022]). Therefore, it would have been obvious to a person of the ordinary skill in the art at the time the invention was made to combine the teachings of Green with the RFID manufacturing of Grabau because it would provide an improved system which has optimum versatility, and can effectively produce a wide variety of different types of RFID labels in a cost effective manner (Grabau, [0002]).

Allowable Subject Matter

3. Claims 15-14 are allowed.

The following is a statement of reasons for the indication of allowable subject matter: The allowability of the claims resides, at least in part, that the closest prior art of record does not disclose or suggest the step of:

Regarding independent claim 5, **a control system coupled with the conveyors and the tester and comprising a machine-readable medium embodying information indicative of instructions that when performed by the control system results in operations comprising moving the first substrate with respect to the tester, identifying good RFID modules using the tester, aligning the good RFID**

Art Unit: 2125

modules with the RFID antennas, and forming RFID tags from the good RFID modules and the RFID antennas, in combination with the other elements and features of the claimed invention.

Claim 17-19, 25-27 and are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

4. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning communication or earlier communication from the examiner should be directed to Zoila Cabrera, whose telephone number is (571) 272-3738. The examiner can normally be reached on M-F from 8:00 a.m. to 5:30 p.m. EST (every other Friday).

If attempts to reach the examiner by phone fail, the examiner's supervisor, Leo Picard, can be reached on (571) 272-3749. Additionally, the fax phones for Art Unit 2125 are (571) 273-8300. Any inquiry of a general nature or relating to the status of this application should be directed to the group receptionist at (703) 305-9600.



Zoila Cabrera
Primary Examiner
8/11/06